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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,418	12/08/2004	Ralf Bonitz	3141	2643

7590 01/11/2006

Striker Striker & Stenby
103 East Neck Road
Huntington, NY 11743

EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

58

Office Action Summary	Application No. 10/517,418	Applicant(s) BONITZ ET AL.	
	Examiner Jordan M. Schwartz	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-17 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10,11 and 13-15 is/are rejected.
- 7) ☒ Claim(s) 12,16 and 17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/04, 4/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on June 14, 2002. It is noted, however, that applicant has not filed a certified copy of this application as required by 35 U.S.C. 119(b). Specifically, the examiner could not find any indication that a certified copy of the priority document was received by PCT or by the patent office. The examiner located a scanned copy of the foreign application in the present application file but it did not appear to be a certified copy as required by the 35 U.S.C. 119(b).

Information Disclosure Statement

The information disclosure statement filed April 20, 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Specifically, a concise explanation of the relevance of DE 1 099 964 was not provided and therefore this reference has been crossed out and has not been considered.

Claim Objections

Claims 10 and 13-17 are objected to because of the following: specifically, these claims reference within parentheses "5", "O", and "P" which are not disclosed within the drawings. It is suggested that applicant either amend the

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drawings to reference the aforementioned or else that they be deleted from the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10, 13/10 and 14/10 are rejected under 35 U.S.C. 102(b) as being anticipated by Shie et al publication number 2001/0033726.

Shie et al disclose the limitations therein including the following: an optical lens having an optically active surface (Figures 1a, 1b, 10a, 10b, paragraphs 0039-0040); the optically surface provided with an embossed fine structure (Figures 1a, 1b, 10a, 10b, paragraphs 0039-0040, the Fresnel pattern as the fine structure); the fine structure extending radially outward in a direction from the optical axis toward an outer periphery (Figure 1a); the fine structure having an undulated form (Figures 1b, 10a, and 10b); and an embossed microstructure provided on the embossed fine structure (Paragraph 0054 i.e. micro-structures

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being provided on the surface of the Fresnel optics). Shie et al further discloses the microstructure arranged concentrically about the optical axis (Figure 1a); and the fine structure and microstructure on a surface region extending concentrically about the optical axis (Figure 1a, paragraph 0054).

Claims 10, 13/10, 14/10, and 15/10 are rejected under 35 U.S.C. 102(e) as being anticipated by Pocius et al publication number 2002/0141006.

Pocius et al disclose the limitations therein including the following: an optical lens having an optically active surface (Figures 2a, 2b paragraph 0043); the optically surface provided with an embossed fine structure (Figures 2a, 2b, the Fresnel pattern as the fine structure); the fine structure extending radially outward in a direction from the optical axis toward an outer periphery (Figure 2a); the fine structure having an undulated form (Figure 2b); and an embossed microstructure provided on the embossed fine structure (claim 10). Specifically, Pocius et al discloses coating the fine structure with a reflective coating. A reflective coating will inherently have small reflective particles within it i.e. will inherently have a "microstructure". Furthermore, since applicant is not claiming any structure or limitations directed to the microstructure other than claiming "a microstructure" then any substance, including a reflective coating will inherently contain or comprise particles, including molecular components i.e. will inherently comprise "a microstructure". Pocius et al further discloses the microstructure arranged concentrically about the optical axis (Figure 2a); the fine structure and microstructure on a surface region extending concentrically about the optical axis

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(Figure 2a); and the microstructure formed on an aspherical surface of the lens (paragraph 0043).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11, 13/11, and 14/11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shie et al in view of Japanese document number 10-123307 (Japanese'307).

Shie et al discloses as is set forth above but does not specifically disclose the fine structure having a roughness in the range of from 1 μm to 10 μm .

It is believed that the micro-structures of Shie et al would inherently have a roughness in the range of from 1 μm to 10 μm , this being reasonably based upon the microstructures producing smoothly varying light, similar to that of the claimed invention, as well as being based upon the large range claimed.

Regardless, Shie et al discloses the microstructure used for the purpose of homogenizing the light (abstract). Japanese'307 teaches that in an optical element using microstructures to provide light homogenization, that it is desirable to have the microstructures with a roughness in a range of from 1 μm to 10 μm for the purpose of providing the desired light diffusion. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was

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made to have the roughness of the microstructure of Shie et al in a range of from 1 μm to 10 μm since Japanese'307 teaches that in an optical element using microstructures to provide light homogenization, that it is desirable to have the microstructures with a roughness within this range for the purpose of providing the desired light diffusion.

Prior Art Citations

Gale et al publication number 2004/0032667, and Shie et al patent number 6,352,359 are being cited herein to show optical lenses having some similar structure to that of the claimed invention.

Allowable Subject Matter

Claims 12, 13/12, 14/12, 15/11-12, and 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to claims 12, 13/12, 14/12, 15/12, none of the prior art either alone or in combination, disclose or teach of the claimed optical lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed fine structure having a roughness within the claimed range and the claimed microstructure having a roughness within the claimed range. Specifically, with

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reference to claim 15/11, none of the prior art either alone or in combination, disclose or teach of the claimed optical lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed fine structure having a roughness within the claimed range and the embossed microstructure on an aspherical side of the lens. Specifically, with reference to claim 16, none of the prior art either alone or in combination, disclose or teach of the claimed optical lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed roughness of the fine structure decreasing in the direction from the optical axis toward the outer periphery. Specifically, with reference to claim 17, none of the prior art either alone or in combination, disclose or teach of the claimed optical lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed roughness of the fine structure of a region oriented toward the optical axis decreases toward another region oriented toward the outer periphery.

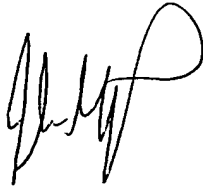
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:30 to 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached at (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz
Primary Examiner
Art Unit 2873
January 5, 2006